

REMARKS

Reconsideration of this application in view of the above amendments and following remarks is respectfully requested. Claims 1-13, 22, 23, 25-33, 36-40, 43-47, 59 and 60 are now pending. Claims 14-21, 24, 34, 35, 41, 42 and 48-58 have been canceled. Claims 1, 3, 5, 6, 11-13, 22, 23 25-27, 30-33, 36-40, 43-46 and 59 have been amended. Applicants thank the examiner for his time to discuss the office action with applicants' representative.

By Final Office Action mailed January 9, 2007, prosecution on the merits has been closed. Accordingly, this Amendment is filed pursuant to 37 C.F.R. §1.116(b)(1), which permits the filing of amendments canceling claims and/or complying with requirements of form. To this end, Applicants have now canceled claims 14-21 and 48-58 as directed to non-elected subject matter. Of course, cancellation of these claims is not, nor should it be construed as, acquiescence to any outstanding rejections, and Applicants reserve the right to continue prosecution of the canceled subject matter in one or more related applications.

Upon cancellation of the above noted claims (as well as cancellation of claims 24, 34, 35, 41 and 42 as discussed below), claims 1-13, 22, 23, 25-33, 36-40, 43-47, 59 and 60 are pending. For purpose of convenience, Applicants will address the pending claims under the following separate headings.

Claims 1-13, 59 and 60

Claims 1-13, 59 and 60 stand allowable (*see* 1/9/07 Office Action at page 3, end of first paragraph).

For purpose of clarity only, Applicants have amended claim 1. More specifically, Applicants have omitted the extraneous period (as requested by the Examiner), inserted the numeral "I" following the structure, clarified that it is the phenyl portion of the benzyl moiety that is optionally substituted, and canceled reference to *n* being 1 with regard to the Y group (to avoid confusion with reference to *n* in the context of the Z group). Also, Applicants have omitted the negative proviso at the end of the claim since the listed

compounds do not fall within the current scope of claim 1 (and thus need not be excised therefrom).

Claims 3, 5, 6, 11 and 12 have been amended to conform these claims to the scope currently recited in claim 1 with regard to the Y moiety.

Claim 13 has been amended to more specifically recite the R₉ moiety as an optionally substituted aryl moiety.

Claim 59 has been amended in a manner consistent with claim 1 (*i.e.*, that the phenyl portion of the benzyl is substituted).

No new matter has been added by way of these amendments, and Applicants request that claims 1-13, 59 and 60 be passed to allowance.

Claims 22, 46 and 47

Claims 22, 46 and 47 stand rejected under 35 U.S.C. §102(b) to the extent they read on subject matter extending beyond the scope of allowable claim 1 (*see* 1/9/07 Office Action at page 3, last paragraph).

As for claim 22, Applicants have now amended this claim to recite a pharmaceutical composition comprising a pharmaceutically acceptable carrier or excipient and a compound of claim 1 (*i.e.*, canceling the text referring to other claims/compounds that extend beyond the scope of allowable claim 1).

Claim 46 has similarly been amended by canceling reference to claims other than allowable claim 1. (Claim 47 depends from claim 46, and thus contains all the limitations of allowable claim 46).

Accordingly, Applicants submit that claims 22, 46 and 47 no longer read on species that extend beyond the scope of claim 1 (and thus stand free of the cited prior art), and request that these claims be passed to allowance.

Claims 23-45

When indicating that claims 1-13, 59 and 60 constitute allowable subject matter, the Examiner stated that "any method of use drawn to these compounds" would also

constitute allowable subject matter (*see* 1/9/07 Office Action at page 3, last sentence of first paragraph). To this end, claims 23-45 are directed to methods of use. Claims 24, 34, 35, 41 and 42 have now been canceled, and the remaining claims (*i.e.*, claims 23, 25-33, 36-40 and 43-45) have been amended in a manner such that they recite only allowable compounds.

More specifically, claims 23, 25, 27, 30, 37, 44 and 45 have been amended to recite a compound of claim 1, and reference to other claims and/or compounds has been canceled. Mention of alternative forms of the compound in claims 27, 30, 37, 44 and 45 has been omitted as duplicative of the language of claim 1. Claims 36 and 43 have been amended to recite the disease state as obesity. Also, claims 31, 32, 38 and 39 have been amended to recite “the compound” (as opposed to “said composition”), and the dependency of claim 26 has been amended to correct a typographical error. No new matter has been added by way of these amendments.

Accordingly, Applicants request that method claims 23, 25-33, 36-40 and 43-45 be rejoined at this stage of prosecution and also passed to allowance.

Amendment to Specification

Lastly, Applicants have amended paragraph [0001] of the specification to update the “Cross-Reference to Related Application” section, and to add the heading “Statement of Government Interest”.

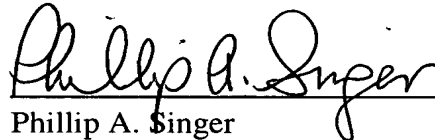
DOCKET NO.: UC2003-C14-2 /UCSF-0004/TRUC-0016
Application No.: 10/825,881
Office Action Dated: January 9, 2007

**PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116**

Conclusion

In view of the above amendments and remarks, allowance of claims 1-13, 22, 23, 25-33, 36-40, 43-47, 59 and 60 is respectfully requested. A good faith effort has been made to place this application in condition for allowance. However, should any further matter require attention prior to allowance, the Examiner is requested to contact the undersigned to resolve the same.

Date: May 17, 2007


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